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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,803	10/07/2003	Laurent P. Kosbach	03092CON	6636
7590	09/20/2007		EXAMINER	
Michelle B. Lando			GHALI, ISIS A D	
Cabot Corporation				
Billerica Technical Center			ART UNIT	PAPER NUMBER
157 Concord Road				1615
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			09/20/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/681,803	KOSBACH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Isis A. Ghali	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 29 June 2007.
- 2a) This action is **FINAL**.                                   2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 13-36 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

The receipt is acknowledged of applicants' amendment filed 06/29/2007.

Claims 1-36 are pending.

### *Election/Restrictions*

1. This application contains claims 13-36 drawn to an invention nonelected with traverse in the reply filed on 01/19/2007. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

2. Applicant request the rejoinder of any non-examined claims upon allowability of the any of the examined claims to the extent such non-examined claims are dependent upon, or include the limitations of any of the allowed claims.

The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of

an allowable product claim for that process invention to be rejoined. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Claims 1-12 are included in the prosecution.

**The following rejection has been overcome by virtue of applicants' amendment and remarks:**

The rejection of claims 1-12 under 35 U.S.C. 112, second paragraph, as being indefinite.

**The following rejections have been discussed in the previous office action, and are maintained for reasons of record:**

***Double Patenting***

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1-36 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-12, 14-25, and 27-38 of copending Application No. 10/959,614. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

5. The examiner acknowledges that applicants intention to address this rejection if and when the referenced application issues as a patent and the rejection is no longer provisional. however, the "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications.

***Specification***

6. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
  
7. Applicants have not indicate revision or making any correction, therefore this objection is maintained.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
  
9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0064020 ('020) by itself or in view of US 6,333,053 ('053).

US '020 teaches alumina particles having  $\delta$  and  $\theta$  crystalline form with primary particles thereof having average particle diameter of 5 to 100 nm and secondary particles resulting from aggregation of primary particles having average particle diameter of 50-800 nm (abstract; paragraphs: 0012, 0013, 0029). The primary particles are loosely aggregated to form secondary particles (paragraph 0079), which reads on fumed alumina because applicants disclosed on page 3, paragraph 0016 that fumed alumina is used to refer to alumina primary particles that aggregate to form larger particles. The reference disclosed the use of alumina particles for cosmetic application (paragraph 0079). The reference further disclosed alumina particles having particle diameter larger than 45  $\mu\text{m}$  (paragraph 0014). The reference disclosed that the particles having diameter larger than 45  $\mu\text{m}$  are contained in an amount about 0.05%, i.e. the particles having diameter less than 45  $\mu\text{m}$  is present in an amount of 99.05%, which meet the requirement of claims 7, 10 and 11. Regarding claim 12, the reference disclosed the particles are mixed form of  $\delta$  and  $\theta$  crystalline alumina particles, i.e. 100% of the particles are mixed form, which reads on the limitation of claim 12 that 30% or more are combined  $\delta$  and  $\theta$  crystalline particles.

US '020 does not teach the amount of fumed alumina in the composition as claimed by claim 1.

However, the claimed amount does not impart patentability to the claims since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide cosmetic composition comprising alumina particles as taught by US '020, and adjust the amount of the particles in the composition according to the specific intended use with reasonable expectation to arrive to the claimed amount of alumina particle in cosmetic composition.

US '053 teaches cosmetic composition comprising particles of metal oxides including aluminum oxide in a preferred amount of 2 to 15% that provides advantageous application makeup for skin, nail and mucous membranes of the human being (abstract; col.2, lines 32-35, 55-63).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide cosmetic composition comprising alumina particles as taught by US '020, and adjust the amount of the particles in the composition to the range between 2 and 15 % as disclosed by US '053, motivated by the teaching of US '053 that amount of the particles in the cosmetic composition between 2-15% is preferred because it provides advantageous application makeup for skin, nail and mucous membranes of the human being, with reasonable expectation of having

cosmetic composition comprising 2-15% of alumina particles wherein the composition provides advantageous application makeup for skin, nail and mucous membranes of the human being.

### ***Response to Arguments***

11. Applicant's arguments filed 06/29/2007 have been fully considered but they are not persuasive. Applicants argue that:

- US '020 teaches fumed alumina particles having specific particle diameters exhibit improved abrasive properties in polishing applications. US '020 publication is not directed to cosmetic compositions US '020 makes a singular, generic reference to cosmetic compositions, stating that "the alumina particles can be used for not only the CMP application, but also the cosmetics application where scrubbing and smooth feeling both are desired", and the reference does not address the particular benefits provided by the use of fumed alumina, nor the use of any particular amount of fumed alumina in cosmetic compositions to achieve such benefits.

In response to this argument, it is argued that US '020 suggested the use of alumina particles for cosmetic application and it has been held that in considering the disclosure of the reference, it is proper to take into account not only the specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). In this case the reference clearly suggested cosmetic use of alumina particles. The reference further provides benefit of using alumina particles which is sooth feeling. Hence, US '020 is applicable under U.S.C. 103. In any events, the present claims are directed to a composition, and the elements of the composition

Art Unit: 1615

are disclosed by US '020, except for the alumina amounts, that are suggested by the reference.

- Applicants argue that US '020 discloses alumina particles having a diameter greater than 45  $\mu\text{m}$ , i.e., greater than 45,000 nm, are present in an amount of about 0.05% by weight or less, and indicates nothing with respect to the weight percent of fumed alumina particles that have an aggregate particle size of 300 nm or less, an agglomerate particle size of 5  $\mu\text{m}$  or more, or an agglomerate particle size of 30  $\mu\text{m}$  or less.

In response to this argument, the examiner is pointing out to the teaching implied from the reference that the particles having diameter less than 45  $\mu\text{m}$  is present in an amount of 99.05%, which meet the requirement of claims 7, 10 and 11, because the particles having diameter larger than 45  $\mu\text{m}$  are contained in an amount about 0.05%. The present claims require more than 3% of fumed alumina. US '020 further teaches aggregation of the particles to form aggregate having diameter between 50-800 nm. Therefore, the particle sizes and their agglomeration are taught by the reference.

- Applicants argue that US '020 does not disclose or suggest all of the elements of the pending claims, and nothing to motivate one of ordinary skill in the art to modify the disclosure of US '020 to arrive at the claimed invention, and the pending claims cannot be considered obvious over US '020.

In response to this argument, it is argued that US '020 teaches all the elements of the claimed composition, which is cosmetic composition and alumina particles, and the only difference between US '020 and the present claims is the amount of the alumina particles, therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide cosmetic composition comprising alumina

particles as taught by US '020, and adjust the amount of the particles in the composition according to the specific intended use with reasonable expectation to arrive to the claimed amount of alumina particle in cosmetic composition. It is the examiner's position that the size are result effective variables because changing them will clearly affect the type of product obtained. See MPEP § 2144.05 (B). Case law holds that "discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art." See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

- Applicants argue that US '053 fails to cure the deficiencies of US '020. US '053 fails to disclose a cosmetic composition comprising fumed alumina in an amount of about 3 wt.% or more. US '053 is directed to the shape of particles used which is preferably polyhedral, while fumed alumina, as the term is used in the pending application, refers to a form of alumina that is comprised of substantially spherical primary particles that are fused together to form irregularly-shaped aggregate particles. Although US '053 discloses that metal oxides such as aluminum oxide may be used, the finned alumina particles of the pending application do not provide the shape required by US '053 patent

In response to this argument, it is argued that the claims do not recite any shapes of the particles, and the reference to the fumed alumina in the specification as "substantially spherical", does not exclude other shapes as disclosed by US '053. US '053 is relied upon for solely teaching of using aluminum oxide particles in a cosmetic composition in amount between 2 to 15% because it is advantageous in application of makeup for skin, nail and mucous membranes of the human being. The claimed fumed alumina is taught by US '020. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

- Applicants argue that there is no motivation that would lead a person of ordinary skill in the art to combine the cited references, which disclose the use of different types of particles in different end-use applications. US '020 is directed to controlling the average particle diameter of filmed alumina, and on the use of these particles to produce specific advantages in CMP applications and US '053 directed to the use of particles in cosmetic compositions, requires alumina with a very specific type of particulate phase that does not encompass the use of the fumed alumina particles recited in the pending claims.

In response to this argument, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide cosmetic composition comprising alumina particles as taught by US '020, and adjust the amount of the particles in the composition to the range between 2 and 15 % as disclosed by US '053, motivated by the teaching of US '053 that amount of the particles in the cosmetic composition between 2-15% is preferred because it provides advantageous application makeup for skin, nail and mucous membranes of the human being, with reasonable expectation of having cosmetic composition comprising 2-15% of alumina particles wherein the composition provides advantageous application makeup for skin, nail and mucous membranes of the human being.

The rational to modify or to combine the prior art does not have to be expressly stated in the prior art; the rational may be expressly or impliedly contained in the prior

art or it may be reasoned from knowledge generally available to one of ordinary skill in the art. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve different problem. It is not necessary that the prior art suggest the combination or modification to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references are in the field of applicant's endeavor and are reasonably pertinent to the particular problem with which the applicant was concerned.

- Applicants argue that the suggestion and benefits of including about 3 wt.% or more of fumed alumina particles in a cosmetic composition are provided only by Applicants' disclosure accompanying the pending claims, and the combination of US '020 US '053 is based on improper use of hindsight on viewing the disclosure accompanying the pending claims.

In response to this argument, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis A. Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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Isis A Ghali  
Primary Examiner  
Art Unit 1615

IG

*Isis Ghali*

**ISIS GHALI**  
**PRIMARY EXAMINER**